

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:

**VON ROSSUM et al.**

Serial No.: 09/508,852  
Filed: June 2, 2000  
For: DEVICE AND METHOD FOR  
MONITORING AND  
COLLECTING QUANTITIES OF  
MOBILE BODIES

Atty. No.: Docket 005032.86955

Group Art Unit: 1746

Examiner: M. Kornakov

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DEC 02 2003  
TC 1700

**REQUEST FOR WITHDRAWAL OF  
FINALITY OF OFFICE ACTION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests the finality of the office action of August 25, 2003 be withdrawn as being improper.

According to the MPEP 706.07(b), "claims of a new application may be finally rejected in the first Office action in those circumstances where (A) the new application is a continuing application of, or substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application."

The claims were amended in the preliminary amendment filed with the RCE. Specifically, claim 30 was amended to recite specific vinyl monomers, the polydispersity and glass transition temperatures. Although the limitations recited were taken from dependent claims, all of the limitations were never before considered together in an independent claim. That is, the limitations of claims 34, 35, and 37, each previously dependent on claim 30, were never considered together. Thus, all claims of the new application are not drawn to the same invention claimed in the earlier application since,

prior to the examination of the claims of the preliminary amendment, no claim was considered containing all of the limitations recited in amended claim 30.

On May 8, 2003, Applicant submitted a response after final rejection. This response was not considered to overcome the rejection, and in fact, a lengthy Advisory Action was issued. A subsequent response after final was considered; however, since the claim 30 was being amended to recite three separate limitations that were not previously considered *together* in a single claim, it was believed that an Advisory Action would be issued stating that the amendment raises new issues and further considerations.<sup>1</sup> This not only would have resulted in an RCE being filed in any event, but also further extensions and possibly a Notice of Appeal being filed to avoid abandonment of the application.

Applicant thus filed the RCE along with a Preliminary Amendment on August 6, 2003 that amended the claims to a new invention that was not claimed in the earlier application. That is, claim 30 was amended to recite three limitations that were never considered *together* in a single claim.

Thus, the amended claims could not have been properly rejected on the grounds and art of record in the next Office action of the earlier application as the amended claims would have been presented *after* a final office action and would have required a new search and/or raised new issues.

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<sup>1</sup> Moreover, it has been the experience that virtually any amendment made after final rejection is considered to raise "new issues" that require further consideration or require a new search. For example, in another application examined in Group 1700, claim 1 was merely amended to recite the limitation of claim 2, but the amendment was not allowed after final. The Examiner argued (and his SPE agreed in an interview) that claim 3 (dependent on claim 1) was never before considered with the limitation of claim 2 and thus new issues were raised.

Applying the standard for a proper final rejection in MPEP 760.07(b) set forth above, since the preliminary amendment could not have been properly rejected on the grounds and art of record, applicant respectfully submits that the final rejection was improper and requests withdrawal of the "final" rejection and entry of the amendments to the claims below.

Respectfully submitted,

By:   
Christopher B. Roth  
Registration No. 49,007

Dated: November 25, 2003

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